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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,528	12/20/2001	Paul Wurzinger	016790-0446	2160

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EXAMINER

CASTELLANO, STEPHEN J

ART UNIT PAPER NUMBER

3727

DATE MAILED: 09/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/022,528

Applicant(s)

WURZINGER, PAUL

Examiner

Stephen J. Castellano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 5, 13, 16 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-12, 14 and 15 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☒ Claim(s) 1-17 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1. 6) ☐ Other: \_\_\_\_\_

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This application contains claims directed to the following patentably distinct species of the claimed invention:

Group I: Fig. 3; and

Group II: Fig. 5.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 appears generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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During a telephone conversation with Mr. Glenn Law on September 12, 2002 a provisional election was made without traverse to prosecute the invention of Group I: Fig. 3, claims 1-4, 6-12, 14 and 15. Affirmation of this election must be made by applicant in replying to this Office action. Claims 5, 13, 16 and 17 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The disclosure is objected to because of the following informalities: The specification and claims specify CVD diamond. There is never any explanation of what the acronym "CVD" means.

Appropriate correction is required.

Claim 9 is objected to because of the following informalities: Claim 9 specifies CVD diamond. There is never any explanation of what the acronym "CVD" means.

Appropriate correction is required.

Claims 1-4, 6-12, 14 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite because the statement that at least one of the shaped parts comprises a diamond is indefinite because the description of a diamond doesn't specify whether a particular material or particular shape is being indicated. Also, the material of a diamond is in and of itself, indefinite. Diamond is carbon having a crystalline form. Many diamonds have impurities. When a diamond material is specified, the true chemical

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composition is somewhat unknown since different crystalline forms, different impurities as well as, different levels of impurities would be present.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 8-12, 14 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Radtke ('618).

The diamonds (26) are considered to be the shaped parts and the drill collar (4), the tubular body (2) and the distal part having cavity (6) are considered shaped parts.

Regarding claim 9, the CVD limitation is believed to refer to a chemical vapor deposition process which doesn't structurally modify the diamond.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6-12, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Radtke.

Radtke discloses a drill bit inherently capable of holding a specimen, drill collar (4) represents a shaped part, tubular body (2) represents a shaped part and the distal part having cavity (6) represents a shaped part.

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For claims 4, 11 and 15, Radtke discloses the invention except for the parts of the drill collar (4) and the distal part having cavity (6) both being considered or consisting of disk-shaped diamonds. <sup>Radtke teaches</sup> It would have been obvious to modify both parts to <sup>comprise</sup> be disk-shaped diamonds in order to provide a more durable, <sup>weaker</sup> crush resistant and abrasion resistant material than metal.

For claim 7, the spacer ring material of gold, aluminum and copper is not specified. Gold, aluminum and copper are well known spacer materials. It would have been obvious to use gold, aluminum or copper as a spacing material because of its good thermal conducting properties in order to keep the temperature inside of the drill bit and outside of the drill bit consistent.

Claims 1-4, 7-12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim.

Kim discloses a segmented container made of three shaped parts.

For claims 4, 11 and 15, Kim discloses the invention except for the top and bottom parts being considered or consisting of disk-shaped diamonds. It would have been obvious to modify both parts to <sup>comprise</sup> be disk-shaped diamonds in order to provide a more durable, crush resistant and abrasion resistant material than metal.

For claim 7, the spacer ring material of gold, aluminum and copper is not specified. Gold, aluminum and copper are well known spacer materials. It would have been obvious to use gold, aluminum or copper as a spacing material because of its good thermal conducting properties in order to keep the temperature inside of the drill bit and outside of the drill bit consistent.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen J. Castellano whose telephone number is 703-308-1035.

The examiner can normally be reached on M-Th 6:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee W. Young can be reached on 703-308-2572. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

  
Stephen J. Castellano  
Primary Examiner  
Art Unit 3727

sjc  
September 19, 2002